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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,050	11/27/2000	Joseph G. Gatto	23449-010	4426
909	7590	06/28/2006	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			SUBRAMANIAN, NARAYANSWAMY	
P.O. BOX 10500			ART UNIT	PAPER NUMBER
MCLEAN, VA 22102			3628	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/722,050	<b>Applicant(s)</b> GATTO, JOSEPH G.	
	<b>Examiner</b> Narayanswamy Subramanian	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-66,68-88 and 90-94 is/are pending in the application.
- 4a) Of the above claim(s) 39-66,68-88 and 90-94 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/10/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This office action is in response to applicant's communication of April 10, 2006. Applicant's election of invention I drawn to claims 1-38, with traverse is acknowledged by the examiner. Claims 39-66, 68-88 and 90-94 are withdrawn from consideration as being drawn to a non-elected invention. Applicants are respectfully advised to cancel the non-elected claims 39-66, 68-88 and 90-94 in reply to this office action. Claims 1-38 have been examined. The rejections and response to arguments are stated below.

**Claim Rejections - 35 USC § 101**

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-38 are rejected because the claimed invention is directed to non-statutory subject matter.

Claims 1-38, the disclosed invention is inoperative and therefore lacks utility.

Claims 1-38 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor).

Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754, where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

### **Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over et al (US Patent) in view of et al (US Patent).

Claim 1, Jennings discloses a computer-implemented system for viewing performance data comprising: a performance view module for viewing performance data for selected contributors (See Jennings Column 31 lines 36-65), performance determining means for determining the performance of selected contributors (See Jennings Column 32 lines 6-10, Column 41 line 34 – Column 43 line 18); and a performance aggregation module for aggregating the earnings estimates performance data for selected contributors according to one or more user-defined criteria (See Jennings Column 43 lines 20 – Column 44 line 53).

Jennings does not explicitly teach earnings estimates performance data.

Official notice is taken that earnings estimates performance data is old and well known in the art. This data helps an investor pick a forecaster and use their forecasts in making investment decisions.

It would have been obvious to one of ordinary skill in the art at the time of invention to include this step to the invention of Jennings. The combination of teachings suggests that investors would have benefited from the forecasts of the forecasters they consider best.

Claims 2-38, Jennings discloses the steps wherein the performance determining means measures and compares contributor performance in absolute terms (See Jennings Column 23 lines 10-21 and Column 31 lines 37-65); wherein contributor performance is measured and compared relative to other contributors' performance (See Jennings Column 31 lines 37-65); wherein contributor performance data comprises user selected error metrics (See Jennings Column 31 lines 37-65, mean, median etc are user elected error metrics); wherein contributor performance data comprises error metrics and wherein contributor performance data is sorted based on user specified criteria (See Jennings Column 31 lines 37-65, sorting is old and well known); means for ranking contributors based on user-selected criteria (See Jennings Column 36 lines 16-19 and claim 31); wherein user-defined criteria comprise one or more of ticker, company name, analyst, CUSIP, and unique ticker (old and well known in Investment art); wherein user-defined criteria comprises one or more of broker, ticker or broker and ticker combination (old and well known in Investment art); displaying, for a selected security, each contributor who made an estimate in the selected fiscal period or periods (See Jennings Claim 31) including displays, for each displayed contributor, summary performance metrics (See Jennings Claim 31); displays, for each displayed contributor, aggregate performance metrics

Art Unit: 3624

(See Jennings Claim 29); displays period-by-period performance for a selected one of the displayed contributors, for the selected security for each period in the selected fiscal periods (See Jennings Column 35 lines 47-67); means for enabling a user to elect to filter the displayed list of contributors who made an estimate in the selected fiscal period or periods to those contributors who have a current estimate is interpreted as intended use and hence not given patentable weight; receiving user defined filter parameters for filtering the displayed list of contributors (See Jennings Column 43 line 20 – Column 44 line 35, new clusters are interpreted to include user defined filter parameters); displaying, for a selected contributor, securities for which that contributor has made an estimate (See Jennings Column 31 lines 37-45); displaying, for a selected contributor, securities for which that contributor has made an estimate in a selected fiscal period (See Jennings Column 31 lines 37-65); displaying, for the selected contributor, and displayed securities, aggregate performance metrics (See Jennings Column 31 lines 37-65, and Column 43 lines 20-30); the aggregate performance metrics are displayed for estimates made during a selected time frame and represent an aggregated performance over each period in the selected period (See Jennings Column 31 lines 37-65, and Column 43 lines 20-30); displaying period-by-period performance for the selected contributor, for a selected one of the displayed securities for each period in the selected fiscal periods (See Jennings Column 31 lines 37-65 and Column 35 lines 47-67); means for enabling a user to select a contributor-security pair is interpreted as intended use and hence not given patentable weight; displaying, for the selected contributor-security pair, period-by-period performance metrics for each period in the selected fiscal periods (See Jennings Column 31 lines 37-65 and Column 35 lines 47-67); displaying for a contributor-security pair at least one historical time-series display (See Jennings Column 31 lines

37-65 and Column 35 lines 47-67); time series display comprises a time-series display of the contributor's estimates and consensus estimates (inherent in Jennings' disclosure); at least one time series display includes a time-series display of the contributor's estimates, consensus estimates, and the actual reported earnings for the security (inherent in Jennings' disclosure); wherein the at least one time series display includes the contributor's estimates, consensus estimates and the actual reported earnings displayed as a vertical bar, with a height indicating the actual reported earnings, on the time axis corresponding to the day the earnings were reported (old and well known); the graphical user interface simultaneously displays one chart for at least one historical time series display, at least one time series display displays of the contributor's estimates and at least one other contributor's estimates for comparison purposes, the at least one other contributor is a best contributor based on predetermined factors, at least one other contributor is a comparison contributor selected by the user, wherein the at least one other contributor is at least one of a high estimate, low estimate or mean estimate (inherent in Jennings' disclosure); wherein the at least one other contributor is an enhanced composite estimate, a time series display of the security's price displayed simultaneously with the at least one historical time series display (inherent in Jennings' disclosure); wherein each contributors' estimate is represented by a line, further comprising means for ensuring that both lines are visible even if the value over a particular time is the same, wherein a first line is displayed as a line with a first thickness and a second line is displayed with a second thickness, selecting criteria to aggregate performance, the criteria including an analyst, a broker or analyst/broker pair (old and well known); wherein the user specified number of periods over which to analyze performance determines how many periods to show in the display of period-by-period data (inherent in

Art Unit: 3624

Jennings' disclosure); a user specified time period prior to the report date, the system determines how far in advance of the report date to include estimates, and means for a user to specify at least the number and type of periods and time window to determine the estimates to be included in an analysis (inherent in Jennings' disclosure).

***Response to Arguments***

6. Applicant's arguments with regards to restriction of inventions have been considered but are not persuasive.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dr. N. Subramanian

June 12, 2006